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09/768,434	01/24/2001	Jeffrey N. Sloan	M-9818 US	2388
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HAMILTON & TERRILE, LLP P.O. BOX 203518 AUSTIN, TX 78720			ART UNIT 3621	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/768,434
Filing Date: January 24, 2001
Appellant(s): SLOAN ET AL.

Stephen A. Terrile
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 19 October 2005 appealing from the Office action mailed 07

January 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 6,654,886 B1

CHALLENGER

11-2003

GB 2,339,488 A

COLLIGAN ET AL.

01-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 14 and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Challener et al, U.S. Patent No. 6,654,886 B1.

As per **Claim 1**, Challener et al discloses a method for purchase verification, comprising the acts of:

- receiving at a server a first message from a computer system, the first message including a service tag, the service tag uniquely identifying the computer system (Col. 3, lines 5-25; Col. 5, lines 64-65 Col. 6, lines 10-20);
- determining at the server if the service tag is valid (Col. 3, lines 9-15; Col. 6, lines 10-25; Col. 6 line 62-Col. 7 line 1); and
- generating a second message from the server, the second message authorizing providing a benefit if the service tag is determined to be valid (Col. 7, lines 1-5).

As per **Claim 14**, Challener et al disclose a system for purchase verification, the system being on a server platform (Figure 1), the server operated by a service provider (Col. 3, lines 20-25), the server configured to communicate with a purchased computer system (Figure 1), the server including a processor and a memory, the server platform configured to communicate with a remote computer system (Figure 1), the system comprising:

- a non-volatile computer readable memory, the non-volatile computer readable memory storing:
 - a database, the database including a set of valid service tags, the valid service tags corresponding to computer systems that purchased a benefit (Col. 3, lines 1-13; Col. 6, lines 1-15); and
 - instructions, executable on the processor, configured to receive a message, the message including a service tag, the service tag uniquely identifying a computer system (Col. 3, lines 5-25; Col. 6, lines 1-5).

As per **Claim 15**, Challener et al further disclose that the message includes a product code such as a service (Col. 1, lines 35-55; Col. 2 line 63-Col. 3 line 6; Col. 3, lines 20-25).

As per **Claim 16**, Challener et al further disclose instructions, executable on the processor, configured to authorize a purchaser to receive a benefit (Col. 3, lines 9-24; Col. 6, lines 40-45; Col. 6 line 61-Col. 7 line 5).

As per **Claim 17**, Challener et al further disclose instructions executable on the processor, configured to verify the service tag, wherein the instructions to verify the service tag further comprise:

- instructions to receive the service tag from the computer system (Col. 3, lines 5-10; Col. 6, lines 1-5 and 35-40);
 - instructions to recall the service tag stored in the server (Col. 3, lines 7-14; Col. 6, lines 10-16);
- and

Art Unit: 3621

- instructions to compare the service tag received from the computer system to the service tag recalled from the server to determine if the service tag received from the computer system matches the service tag recalled from the server (Col. 3, lines 7-20; Col. 6 line 62-Col. 7 line 10).

As per Claim 18, Challener et al further disclose instructions, executable on the processor, configured to authorize a purchaser to receive a benefit if the service tag received from the computer system matches the service tag recalled from the server (Col. 3, lines 7-20; Col. 6 line 62-Col. 7 line 10).

As per Claim 19, Challener et al further disclose instructions, executable on the processor, configured to establish an internet service provider service account if the service tag received from the computer system matches the service tag recalled from the server (Col. 3, lines 20-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challener et al, U.S. Patent No. 6,654,886.

As per Claims 2 and 10, Challener et al fail to specifically disclose invalidating the service tag after generating the second message. However, takes official notice that invalidating access to a service when it has been depleted was well known in the art at the time of applicant's invention. Challener et al

Art Unit: 3621

describes that the service being accessed by the client may be any type of service for which access needs to be controlled (Col. 3, lines 20-25). Examiner submits that it was known in the art to invalidate a token or other identifier after the client no longer met the requirements for access. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challenger et al and invalidate the client's log-in token in cases where the client has accessed a one time service or has otherwise depleted the allowed access. The motivation would be to ensure that the service tag or token cannot be used again and thereby reduce the possibility of fraud.

As per Claims 3 and 9, Challenger et al further disclose that the message includes a product code such as a service (Col. 1, lines 35-55; Col. 2 line 63-Col. 3 line 6; Col. 3, lines 20-25).

As per Claim 8, Challenger et al disclose a method for purchase verification, comprising the acts of:

- receiving a first message at a first server, the first message being sent from a computer system, the first message including a service tag, the service tag uniquely identifying a computer system (Col. 3, lines 5-25; Col. 5, lines 64-65; Col. 6, lines 10-20); and
- transmitting a message allowing access to the benefit (Col. 7, lines 1-5).

Challenger et al, however, fails to explicitly disclose transmitting a second message from the first server to a second server, the second server attempting to verify the validity of the service tag. Examiner takes official notice that using a second server or even a third party server for validating tokens or other items used for identification purposes was well known in the art at the time of applicant's invention. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challenger et al and include using a second server for the specific purpose of validating a token or other item used for identification purposes. One would have been motivated to use a second server for validation procedures in order to reduce the necessary processing conducted by the primary server.

As per Claim 20, Challener et al fail to specifically disclose invalidating the service tag after generating the second message. However, takes official notice that invalidating access to a service when it has been depleted was well known in the art at the time of applicant's invention. Challener et al describes that the service being accessed by the client may be any type of service for which access needs to be controlled (Col. 3, lines 20-25). Examiner submits that it was known in the art to invalidate a token or other identifier after the client no longer met the requirements for access. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challener et al and invalidate the client's log-in token in cases where the client has accessed a one time service or has otherwise depleted the allowed access. The motivation would be to ensure that the service tag or token cannot be used again and thereby reduce the possibility of fraud.

Claims 4-7 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challener et al, U.S. Patent No. 5,654,886 B1 in view of Colligan et al, GB 2339488 A, published 26 January 2000.

As per Claims 4-5, Challener et al disclose a method for purchase verification, comprising the acts of:

- generating a service tag that uniquely identifies a computer system, the computer system including a processor coupled to a memory (Figure 2; Col. 3, lines 7-24; Col. 5, lines 45-50 and 60-65);
- receiving a message at a server sent from the computer system, the message including the service tag (Col. 3, lines 5-10; Col. 6, lines 1-5);
- verifying that the service tag value as received matches a service tag value stored in the server (Col. 3, lines 9-24; Col. 6, lines 40-45; Col. 6 line 61-Col. 7 line 5);
- authorizing receipt of a benefit if the received service tag matches (Col. 3, lines 9-24; Col. 6, lines 40-45; Col. 6 line 61-Col. 7 line 5).

Challener et al, however fail to explicitly disclose storing the service tag in the memory at assembly of the computer system. Colligan et al disclose a system for downloading custom software to a unique computer and only authorizes the software to be downloaded if the computer is identified by the

Art Unit: 3621

correct unique service tag (Page 4, lines 15-24; Page 5, lines 5-13; Page 9, lines 15-17; Page 10, lines 1-11). Colligan et al further disclose that the unique identifier for the specific computer is known as a service tag and is "burned" into a hidden section of non volatile memory such as the BIOS within the computer during the manufacturing process of the computer (Page 10, lines 6-11; Page 13, lines 7-22). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challener et al and utilize a unique identifier or service tag which is burned into non-volatile memory in order to uniquely identify the computer requesting services as taught by Colligan. One would have been motivated to use this type of identifier since it is an effective means for uniquely identifying a specific computer to ensure that the identified computer is the one authorized to receive any type of service, access or software download.

As per Claim 6, Challener et al further disclose generating a second message, the message authorizing a purchaser to receive the benefit, if the service tag matches (Col. 3, lines 10-13; Col. 6, lines 40-45; Col. 6 line 61-Col. 7 line 5).

As per Claim 7, Challener et al further disclose wherein the benefit is Internet Service Provider service (Col. 3, lines 20-25).

As per Claim 11, Challener et al disclose a system, the computer system including a processor (Figure 2), the system comprising:

- a non-volatile computer readable memory (Figure 2), the non-volatile computer readable memory including:

- instructions, executable on the processor, configured to store a service tag to uniquely identify the computer (Figure 2; Col. 3, lines 7-24; Col. 5, lines 45-50 and 60-65);

- instructions, executable on the processor, configured to send the service tag to a remote server (Col. 3, lines 5-10; Col. 6, lines 1-5).

Challener et al, however fail to explicitly disclose storing the service tag in the memory at assembly of the computer system. Colligan et al disclose a system for downloading custom software to a unique computer and only authorizes the software to be downloaded if the computer is identified by the correct unique service tag (Page 4, lines 15-24; Page 5, lines 5-13; Page 9, lines 15-17; Page 10, lines 1-11). Colligan et al further disclose that the unique identifier for the specific computer is known as a service tag and is "burned" into a hidden section of non volatile memory such as the BIOS within the computer during the manufacturing process of the computer (Page 10, lines 6-11; Page 13, lines 7-22). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challener et al and utilize a unique identifier or service tag which is burned into non-volatile memory in order to uniquely identify the computer requesting services as taught by Colligan. One would have been motivated to use this type of identifier since it is an effective means for uniquely identifying a specific computer to ensure that the identified computer is the one authorized to receive any type of service, access or software download.

As per Claim 12, Challener et al further disclose that the message includes a product code such as a service (Col. 1, lines 35-55; Col. 2 line 63-Col. 3 line 6; Col. 3, lines 20-25).

As per Claim 13, Challener et al, however, fails to explicitly disclose communicating with a remote server, the server having the ability to verify the service tag. Examiner takes official notice that using a second server or even a third party server for validating tokens or other items used for identification purposes was well known in the art at the time of applicant's invention. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challener et al and include using a second server for the specific purpose of validating a token or other item used for identification purposes. One would have been motivated to use a second server for validation procedures in order to reduce the necessary processing conducted by the primary server.

(10) Response to Argument

ISSUE 1

Regarding claims 1 and 14: On page 7 of the brief, Appellant asserts, "Challenger does not disclose or suggest a purchase verification method which uses a service tag as Claimed by both independent Claims 1 and 14. Applicant's submit that log-in tokens as set forth by Challener do not disclose or suggest the use of service tags as defined and used in the application and Claims of the present application." On the previous pages of the brief the Appellant has gone into great detail regarding the intended structure of the service tags. However, Appellant does not transfer this explicit language into the claims. With regard to the Applicant's assertions that the prior art of record does not fairly teach or disclose each and every limitation contained within the claims, it appears as if the Applicant is reading limitations into the claims from the specification. Ergo, the Examiner has taken the broadest and most reasonable interpretation of the claim limitations as written, in light of the specification. Although the specification may contain recitations of intended use, alternative points of view and subjective interpretative differences between the prior art of record and the present invention as premeditated, it is the claims themselves that are given patentable weight only inasmuch as they are constructed. Because the claimed invention has been painted with the broad stroke of petitioning for limitations that encompasses more than is asserted in the Applicant's claims, the prior art of record continues to fully discloses the Applicant's inventions *as claimed*.

Regarding claims 2, 3, 8, 9, 10, and 20: On page 13 of the brief the Appellant notes that the Examiner has based his rejection on the combination of Challener and **Official Notice**, and on page 14 of the brief appears to dispute this rejection. Subsequently, the common knowledge declared to be well-known in the art is hereby taken to be admitted prior art because the Appellant either failed to traverse the Examiner's assertion of **Official Notice** or failed to traverse the Examiner's assertion of **Official Notice** adequately. To adequately traverse the examiner's assertion of **Official Notice**, the Appellant must

specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the Examiner's assertion of **Official Notice** would be inadequate. Support for the Appellant's assertion of should be included. Appellant has accomplished none of these steps.

Reading claims 4 and 11: On page 17 of the brief, Appellant asserts, "As discussed in detail above, Challenger does not disclose or suggest a purchase verification method which uses a service tag as Claimed by independent Claims 4 and 11. Applicant's submit that log-in tokens as set forth by Challenger do not disclose or suggest the use of service tags as defined and used in the application and Claims of the present application. Additionally, merely replacing the log-in tokens as set forth by Challenger with a service tag as disclosed by Colligan does not disclose or suggest the invention as Claimed." As noted above, Appellant does not transfer this explicit language into the claims. With regard to the Applicant's assertions that the prior art of record does not fairly teach or disclose each and every limitation contained within the claims, it appears as if the Applicant is reading limitations into the claims from the specification. Ergo, the Examiner has taken the broadest and most reasonable interpretation of the claim limitations as written, in light of the specification. Although the specification may contain recitations of intended use, alternative points of view and subjective interpretative differences between the prior art of record and the present invention as premeditated, it is the claims themselves that are given patentable weight only inasmuch as they are constructed. Because the claimed invention has been painted with the broad stroke of petitioning for limitations that encompasses more than is asserted in the Applicant's claims, the prior art of record continues to fully discloses the Applicant's inventions as *claimed*.

Regarding Claims 5-7: On page 17 of the brief, Appellant asserts, "Additionally, Challenger and Colligan do not disclose or suggest certain features of Claims 5-7. More specifically, Challenger and Colligan do not disclose or suggest a service tag used as

Art Unit: 3621

Claimed where the service tag is stored as part of a computer system BIOS as required by Claim 5; a second message authorizing a purchaser to receive the benefit if the service tag matches as required by Claim 6; or, the benefit being an Internet Service Provider service as required by Claim 7.” The Examiner flatly disagrees with this assertion and points to the rejections of claims 5-7 above.

Regarding Claims 12 and 13: On page 18 of the brief, Appellant asserts, “Additionally, Challenger and Colligan do not disclose or suggest certain features of Claims 12 and 13. More specifically, Challenger and Colligan do not disclose or suggest storing a product code identifying a benefit as required by Claim 12 or communicating with a remote server having the ability to verify the service tag as required by Claim 13.” The Examiner flatly disagrees with this assertion and points to the rejections of claims 12 and 13 above. In addition, the common knowledge declared to be well-known in the art is hereby taken to be admitted prior art because the Appellant either failed to traverse the Examiner's assertion of **Official Notice** or failed to traverse the Examiner's assertion of **Official Notice** adequately. To adequately traverse the examiner's assertion of **Official Notice**, the Appellant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the Examiner's assertion of **Official Notice** would be inadequate. Support for the Appellant's assertion of should be included. Appellant has accomplished none of these steps.

In response to applicant's argument that, “Challenger and Colligan are non-analogous prior art because Challenger relates to permitting access to a service executing on a server and Colligan relates to prohibiting loading of a software image on to a computer.” It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case,

Art Unit: 3621

each of the references disclose methods and systems well-known in the art for providing data transfer between nodes within a computer network.

Applicant argues that there is no motivation to combine the applied references. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. Although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lulu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Within *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select passages of reason and logic which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex pane Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Application/Control Number: 09/768,434

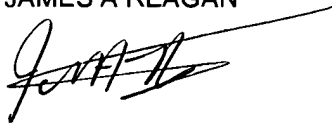
Page 15

Art Unit: 3621

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

JAMES A REAGAN



PRIMARY EXAMINER

ART UNIT 3621

23 March 2006

Conferees:

JAMES TRAMMELL 

SAM SOUGH 